

IN THE HIGH COURT OF GUJARAT AT AHMEDABAD

**APPEAL FROM ORDER No. 327 of 2005
With
CIVIL APPLICATION No. 9090 of 2005
In APPEAL FROM ORDER No. 327 of 2005**

For Approval and Signature:

HONOURABLE MR.JUSTICE K.M.MEHTA

=====

1 Whether Reporters of Local Papers may be allowed
to see the judgment ? **-Yes.**

2 To be referred to the Reporter or not ? **-Yes.**

3 Whether their Lordships wish to see the fair copy
of the judgment ? **-No.**

4 Whether this case involves a substantial question
of law as to the interpretation of the
constitution of India, 1950 or any order made
thereunder ? **-No.**

5 Whether it is to be circulated to the civil judge
? **-No.**

=====

**NANAVATI SOAP AND CHEMICAL WORKS - Appellant(s)
Versus
SHANTI KUTIR KHADI GRAM UDHYOG TRUST - Defendant(s)**

=====

Appearance :

MR YJ TRIVEDI for Appellant(s) : 1,
MR BHARAT T RAO for Defendant(s) : 1,

=====

CORAM : HONOURABLE MR.JUSTICE K.M.MEHTA

Date : 18/04/2006

ORAL JUDGMENT

1.Nanavati Soap and Chemical Works, appellant has filed

this appeal against the judgment and order dated 19/9/2005 passed by the Chamber Judge, City Civil Court, Ahmedabad, order below Exh.29 in Civil Suit No.1257 of 2005. By the impugned order, the learned Judge has observed that I do not find any reasonable cause to restrain the defendant from using the work 'NEW MARUTI', but, the defendant shall use the word 'NEW' in the said print and in the same fashion they are using the word 'MARUTI'. Considering the submissions made by the LA for the parties, the notice of motion is extended, but, the defendant is permitted to use the word 'NEW MARUTI' till the final hearing of the notice of motion application. Appeal Form Order has been filed on 28/9/2005.

2.The facts giving rise to this appeal are as under:

2.1) The plaintiff has filed suit against the defendant being Suit No.1257 of 2005 before the Hon'ble City Civil Court, Ahmedabad for infringement and passing off action, as the defendant is infringing the registered trademark 'MARUTI' in respect of soap by using the mark 'MARUTI' and prayed for injunction on the ground of infringement and passing off action under the provision

of Trade Mark Act.

2.2) In the plaint, it was stated that plaintiff who is using the Trade Mark 'MARUTI' since 1984 and the defendant-respondent have adopted the mark 'MARUTI' which came to the knowledge of the plaintiff in October 2002, hence the plaintiff sent a Registered A.D. Notice to the defendant. The defendant sent their reply stating that they have applied for registration on 1/1/2000. The plaintiff has filed the opposition to the said registration of the mark, as the said mark was advertised in the trade marks journal. The said opposition is under No.AMD-1147.

2.3) It is the case of the plaintiff that the defendant's mark is advertised in the trade marks journal on 29/6/2003 under Application No.929245 dated 1/1/2000 as 'Proposed to be used'. The label which is now used by the defendant is different than the one shown in the application.

2.3A) In view of the aforesaid facts, the plaintiff has filed the suit before the learned City Civil Court and the City Civil Court has granted ex-parte injunction

dated 22/7/2005. The defendant has filed their reply on 26/8/2005. The plaintiff has filed rejoinder on 8/9/2005. Though notice of motion was not fully heard, the learned Judge on 19/9/2005, modified the injunction order and held that "The defendant could not carry out their business due to the injunction and they may be permitted to do their business in the name of NEW MARUTI." The learned Judge has further considered that "It would not be possible for the Court to conclude the argument, looking to the voluminous records of the case, hence the defendant was allowed to use the word 'NEW MARUTI' in their label vide order dated 9/9/2005.

2.4) Being aggrieved and dissatisfied with the said order, present Appeal From Order has been filed by the original plaintiff. Along with the Appeal, Civil Application has been also filed by the plaintiff in this behalf.

3.Mr. Y.J.Trivedi, learned advocate has stated that earlier this Court (Coram:A.L.Dave, J.)has passed an order on 30/9/2005 and also order from time to time and ultimately this Court (Coram:K.M.Mehta, J.) has passed an order on 24/3/2006.

4.It is the case of the appellant/plaintiff that it is the duty of the learned Judge to hear and dispose of the notice of motion on merits of the matter. It is not the obligation of the learned Judge to pass an order that as there is no time to hear the notice of motion, the defendant is allowed to use the word 'NEW MARUTI' till the final hearing of the notice of motion application, particularly there was no such prayer by either side in the suit. Such order was passed on 19/9/2005 and therefore, notice of motion has not been heard and disposed of.

5.Mr.B.T.Rao, learned advocate for the defendant has stated that he desires to have some time to obtain instructions. As I indicated above, the matter is pending since 4/10/2005 and matter is adjourned from time to time. In fact this Court has also granted time to Mr.B.T.Rao on 3/3/2006, 10/3/2006, 17/3/2006 and 17/4/2006 in this behalf. In view of the same, it is not possible to accept the request of Mr.B.T.Rao, learned advocate. Earlier enough indulgence has been given to Mr.B.T.Rao, learned advocate.

6.I have considered the facts and circumstances of the case. From the averments made in the Appeal From Order, it is recorded that appellant-original plaintiff is a registered partnership firm engaged in the business of manufacturing and marketing of soap, detergent cake, washing powder and cleaning preparation since last many decades. The appellant has adopted and used distinct trademark 'MARUTI' in respect of detergent cake and other cleaning products in the year 1984 and has used the trademark 'MARUTI' extensively and continuously in the market. The appellant has acquired tremendous goodwill and reputation the market and thereby, the product containing the trademark 'MARUTI' is capable to cannote and denote the product of the appellant along and none else among the trade and the purchasing public.

7.Appellant thereafter applied for registration of the trademark 'MARUTI' under the provisions of the Trade & Merchandise Marks act, 1958 under No.475161 in class-03 for washing soap on 14/7/1987, which is renewed from time to time. The said registration is valid, subsisting and is in force till today.

8.Appellant came to know that the defendant has started using the trademark 'MARUTI'. The appellant has issued notice and ultimately filed a suit being Civil Suit No.1257 of 2005 before the City Civil Court, Ahmedabad on 22/7/2005.

9.In the said suit, the learned Chamber Judge has passed ex-parte injunction order. Thereafter, the defendant-respondent appeared through their advocate, and have prayed for time for giving the reply therefore, the ex-parte injunction is extended on the application of the appellant on 29/7/2005, 8/8/2005, 17/8/2005, 22/8/2005 and 26/8/2005. Thereafter, the respondent have filed their reply and the matter is placed for filing rejoinder and therefore, ex-parte granted is extended on 8/9/2005, 15/9/2005 and 19/9/2005.

10.The appellant thereafter submitted that on 19/9/2005, when the matter was placed on the returnable board, the learned Chamber Judge, City Civil Court, Ahmedabad had lots of matters on board with various other hearings of injunction applications and was not in a position to hear the injunction application of the appellant and therefore, the appellant moved for extension of the

injunction till hearing of injunction application is heard fully. On the request of the respondent's advocate, the Hon'ble Court, without giving a hearing and deciding the injunction application on merits of the matter, have passed an order on Extension Petition, Exh.29 modifying the injunction on 19/9/2005 as I have stated earlier. It may be noted that the learned Judge has passed this order suo motu as there has no application of either side.

11.The learned advocate for the appellant has submitted that the learned Judge allowed the defendant to use the mark 'MARUTI' by adding the word 'NEW' as a prefix till the final hearing of injunction application. In view of this, the present appellant has filed the present Appeal From Order assailing the order of the learned Trial Judge on various grounds.

12.The learned advocate for the appellant has stated that it is incumbent for the learned Judge to hear and decide the injunction application particularly in the case of trademark. It is his case that when the appellant has used the trademark 'MARUTI', it is registered trade mark but when the defendant used the

same, there is a clear case of infringement of Trade Mark. Therefore, it was the duty of the learned Trial Judge to extend the injunction and hear the matter on merits of the matter. It is the case of the original plaintiff that by passing the said order, the learned Judge has not properly considered the judgment of the Hon'ble Apex Court in the case of Ruston v. Ruston India, reported in AIR 1970 SC 1649, wherein para 8 of the said judgment, the Hon'ble Court has stated that "If the respondent's trademark is deceptively similar to that of the appellant, the fact that the word INDIA is added to the respondent's trademark is of no conclusion and the appellant is entitled to succeed in any action for infringement of trademark." The learned advocate has relied upon another judgment of the Hon'ble Apex Court in the case of Krishna Chennakrishna Chetiar v. Shri Ambal & Co. and another, reported in AIR 1970 SC 146 where the Hon'ble Apex Court has considered in para 8 that addition of SHRI as a prefix of AMBAL does not make any change. Even the addition of prefix RADHA AMBAL does not make any change and considered the mark deceptively and infringement of trademark.

13.The order of the learned Judge is contrary to and inconsistent with the principle laid down by the above judgments of the Supreme Court.

14.The learned Judge ought to have considered that in this case even the respondent have not filed any application and there was no opportunity given to the appellant-plaintiff to give reply or argue their case in this behalf.

15.It is further submitted that the Trial Court has passed an order arbitrarily without going into the facts and law and the material before him and passed the order allowing the respondent to use the trademark MARUTI by addition of the prefix NEW, which is contrary to the law.

16.The learned advocate further submitted that from the record of the case, it is very clear that because of the injunction order respondent have not stopped or closed down because the respondent-defendant are using various other marks namely UMANG SUPER, UMANG, UMANG DELUX, UMANG TOP. Thus, defendant have continued their illegal business under the said mark. Therefore, it is

a wrong conclusion of the Hon'ble Court while passing the order that "the defendant could not do their business of injunction." The said statement of the Hon'ble Court is contrary to the facts and records.

17.The learned advocate has submitted that when the respondent has filed application before the Assistant Registrar of Trade Marks in opposition proceedings, they have passed following order:

"Proceedings having been taken under section 21 of the Trade Marks Act, 1999 by the above named opponents to oppose the registration of a trade mark MARUTI (label) applied for registration by the above named applicants and whereas the aforesaid application has already been refused registration in opposition No.AMD-118321, therefore, the aforesaid opposition No.AMD-114792 abates."

18.I have considered the facts and circumstances of the case. I have considered the judgment of the Hon'ble Apex Court in this behalf. I have also considered the submissions made by learned advocate for the appellant

and learned advocate for the defendant in this behalf. The defendant has tried to defend the order passed by the trial Court in this behalf.

19. It is for the Court to decide the question of comparison of competent mark as a whole distinctive and essential feature. The learned Judge ought to have considered that both the marks are known by their distinctive feature, word MARUTI. Once the defendant has incorporated the whole of the plaintiff's registered trademark, addition of word NEW will not affect the issue. Once the mark is shown the effect, the defendant cannot escape from the liability by showing that something similar but actual mark is different from the mark of the registered proprietor. Meanwhile by adding 'NEW' against word 'MARUTI', the nature and complexion of the matter cannot be changed.

20. In my view, therefore, the order of the learned Trial Judge is liable to be quashed and set aside on two grounds.

1) When the learned Judge without taking into consideration and without deciding application allowed the defendant to use the word 'NEW MARUTI', the learned

Judge has erred in deciding the matter.

2) While doing so, the learned Judge has failed and neglected to consider the settled position of law which I have considered in this behalf.

21.I have only considered two Supreme Court Judgments. There are other judgments also which I have not referred to in this behalf but the law is settled. In view of the same, order of the learned Trial Judge is quashed and set aside. Appeal From Order is allowed.

22.The learned Judge is requested to hear the injunction application on merits of the matter. Meanwhile, the defendant will not use word 'NEW MARUTI' in relation to his products till the injunction application is heard and decided by the Trial Court. The learned Trial Judge is requested to decide the matter as expeditiously as possible but later than 1/8/2006. Appeal From Order is disposed of. Civil Application is also disposed of accordingly.

(K.M.MEHTA, J.)

(ila)